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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,586	02/18/2004	Christopher M. Hill	010.P001	4744

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Berkeley Law and Technology Group
680 NW Altishin Place
Beaverton, OR 97006

EXAMINER

HENRY, RODNEY M

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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,586	Applicant(s) HILL, CHRISTOPHER M.	
	Examiner RODNEY HENRY	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a non-final, first office action on the merits. Claims 1-41, as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-35, 40, and 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-35, 40, and 41, as best understood, it appears that the claimed method steps or processes are not statutory. Based on Supreme Court precedent ¹ and Federal Circuit decisions a §101 process must

(1) be meaningfully tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. ²

The independent claim is directed towards steps of “receiving”, “providing”, and “publishing”. Since the claims are directed to a method or a process without imposing meaningful limits on the method claim’s scope (beyond data gathering and outputting, as two examples), these claims are non-statutory.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advance. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-12, 26-34, 36, 40, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (US 2004/0167928).**

As per Claim 1:

Anderson et al. discloses a method for providing web page content, comprising:
receiving user data (see paragraph [0029]);
providing at least a portion of said user data to an ad network;
receiving electronic data from said ad network (see paragraph [0037]); and
publishing web page content on a web page, wherein said web page content is based at least in part on said electronic data (see paragraphs [0046], [0051]).

As per Claim 2:

Anderson et al. discloses said publishing comprises: generating web page content by use of said electronic data (see paragraph [0062]).

As per Claim 3:

Anderson et al. discloses said generated web page content comprises generating an ad (see paragraph [0062]).

As per Claim 4:

Anderson et al. discloses said ad comprises a text-based ad (see paragraph [0028]).

As per Claim 5:

Anderson et al. discloses said receiving user data further comprises being provided with electronic data, wherein said electronic data comprises data provided by a user (see paragraph [0029]).

As per Claim 6:

Anderson et al. discloses said data provided by a user comprises one or more search terms (see paragraph [0029]).

As per Claim 7:

Anderson et al. discloses said data provided by a user comprises at least a portion of a Uniform Resource Locator (URL), wherein said URL identifies a web page requested by a user (see paragraphs [0046], [0051]).

As per Claim 8:

Anderson et al. discloses said web page requested by a user comprises a first web page (see paragraphs [0046], [0051]).

As per Claim 9:

Anderson et al. said publishing web page content comprises publishing web page content on a second web page (see paragraphs [0046], [0051]).

As per Claim 10:

Anderson et al. discloses said first and said second web page are associated with differing URLs (see paragraphs [0046], [0051]).

As per Claim 11:

Anderson et al. discloses said first web page comprises a search engine web page (see paragraphs [0014], [0032]).

As per Claim 12:

Anderson et al. discloses said second web page comprises a publisher web page (see paragraph [0065], and Table on page 8).

As per Claim 26:

Anderson et al. discloses a method for providing web page content, comprising:
receiving user data (see paragraph [0029]);
providing at least a portion of said user data to an ad network;
receiving electronic data from said ad network (see paragraph [0037]); and
publishing an ad on said web site, said ad being based at least in part on said electronic data (see paragraphs [0046], [0051]).

As per Claim 27:

Anderson et al. discloses said publishing comprises: generating said ad by use of said electronic data (see paragraph [0062]).

As per Claim 28:

Anderson et al. discloses said ad comprises a text-based ad (see paragraph [0028]).

As per Claim 29:

Anderson et al. discloses said receiving user data further comprises being provided with electronic data, wherein said electronic data comprises data provided by a user (see paragraph [0029]).

As per Claim 30:

Anderson et al. discloses said data provided by a user comprises at least a portion of a Uniform Resource Locator (URL), wherein said URL identifies a user requested web site (see paragraphs [0046], [0051]).

As per Claim 31:

Anderson et al. discloses said user requested web site comprises a first web site (see paragraphs [0046], [0051]).

As per Claim 32:

Anderson et al. discloses said first web site comprises a search engine web site (see paragraphs [0014], [0032]).

As per Claim 33:

Anderson et al. discloses said web site publishing said ad comprises a second web site (see paragraphs [0011], [0014]).

As per Claim 34:

Anderson et al. discloses said second web site includes ads from multiple advertisers (see paragraphs [0011], [0014]).

As per Claim 36:

Anderson et al. discloses a system, comprising:

a web server;

a web site, wherein said web site is embodied at least partially on said web server, and wherein said web site is capable of being accessed by a user;

an ad network, said ad network comprising multiple web servers;

said web site server being capable of sending electronic data to one or more web servers of said ad network, wherein said electronic data is based at least in part on data provided by said user, and wherein said one or more web servers of said ad network being capable of returning electronic data to said web site server, wherein said returned electronic data is based at least in part on said data provided by said user (see paragraphs [0029], [0037], [0046], [0051]).

As per Claim 40:

Anderson et al. discloses a web page, comprising:

web page content, said web page content further comprising one or more ads, wherein said one or more ads are provided by an ad network, wherein said one or more ads are based at least in part on a Uniform Resource Locator (URL) associated with the web page (see paragraphs [0029], [0037], [0046], [0051]).

As per Claim 41:

Anderson et al. discloses said one or more ads comprise one or more text-based ads (see paragraph [0028]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-25, 35, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 2004/0167928), in view of Murphy (US 6,615,247).

As per Claim 13:

Anderson et al. does not explicitly disclose said ad network is capable of parsing at least a portion of said user data.

However, Murphy discloses said ad network is capable of parsing at least a portion of said user data (see col 4, lines 6-16 and claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing of user data to the system of Anderson et al.. One would have been motivated to do this in order to make appropriate inferences about customer's needs.

As per Claim 14:

Anderson et al. does not explicitly disclose said receiving electronic data from said ad network comprises: determining a correlation for at least a portion of the parsed data, wherein said correlation may be based, at least in part, on one or more database queries.

However, Murphy discloses said receiving electronic data from said ad network comprises: determining a correlation for at least a portion of the parsed data, wherein said correlation may be based, at least in part, on one or more database queries (see col 4, lines 50-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing of customer data and correlation with respect to database queries to the system of Anderson et al.. One would have been motivated to do this in order to make appropriate inferences about customer's needs.

As per Claim 15:

Anderson et al. does not explicitly disclose said receiving electronic data further comprises being provided with correlation results, wherein said correlation results are determined by said ad network.

However, Murphy discloses said receiving electronic data further comprises being provided with correlation results, wherein said correlation results are determined by said ad network (see col 4, lines 50-64).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add correlation results, wherein said correlation results are determined by said ad network the system of Anderson et al.. One would have been motivated to do this in order to provide appropriate ads to the customer.

As per Claim 16:

Anderson et al. does not explicitly disclose said correlation results comprise data identifying an ad.

However, Murphy discloses said correlation results comprise data identifying an ad (see col 4, lines 50-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add correlation results comprise data identifying an ad to the system of Anderson et al.. One would have been motivated to do this in order to provide the appropriate advertising to customers.

As per Claim 17:

Anderson et al. does not explicitly disclose said data identifying an ad comprises ad content.

However, Murphy discloses said data identifying an ad comprises ad content (see col 4, lines 50-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add said data identifying an ad comprises ad content to the system of Anderson et al.. One would have been motivated to do this

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in order to provide the appropriate advertising to customers such as for goods and for services.

As per Claim 18:

Anderson et al. discloses a method for providing web page content, comprising:: receiving user data at a first web page (see paragraph [0029]); and providing one or more sets of electronic data, based at least in part on said query to a second web page (see paragraphs [0014], [0046], [0051]).

Anderson et al. does not explicitly disclose parsing at least a portion of the user data; querying one or more databases with at least a portion of the parsed data.

However, Murphy discloses parsing at least a portion of the user data; querying one or more databases with at least a portion of the parsed data (see col 4, lines 6-16 and claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing of user data to the system of Anderson et al.. One would have been motivated to do this in order to make appropriate inferences about customer's needs.

As per Claim 19:

Anderson et al. discloses said receiving user data comprises receiving at least one query term; wherein said querying comprises querying by use of said at least one query term; and wherein providing one or more sets of electronic data comprises

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providing a generated ad in the form of electronic data to said second web page (see paragraphs [0014], [0046], [0051]).

As per Claim 20:

Anderson et al. discloses said user data is received from a publisher web site that includes said first web page (see paragraphs [0046], [0051]).

As per Claim 21:

Anderson et al. discloses said user data comprises one or more search terms (see paragraphs [0014], [0032], [0029]).

As per Claim 22:

Anderson et al. discloses said one or more sets of electronic data comprise one or more ads (see paragraphs [0011], [0014]).

As per Claim 23:

Anderson et al. discloses said one or more ads comprise one or more text-based ads (see paragraphs [0028]).

As per Claim 24:

Anderson et al. discloses said data received comprises at least a portion of a Uniform Resource Locator (URL), wherein said URL identifies a web page requested by a user (see paragraphs [0046], [0051]).

As per Claim 25:

Anderson et al. does not explicitly disclose said querying comprises determining a correlation between said received data and data stored in one or more databases.

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However, Murphy discloses said querying comprises determining a correlation between said received data and data stored in one or more databases (see col 4, lines 6-16 and claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add determining a correlation between said received data and data stored in one or more databases to the system of Anderson et al.. One would have been motivated to do this in order to make appropriate inferences about customer's needs.

As per Claim 35:

Anderson et al. does not explicitly disclose said web server is further configured to, in operation: at least partially parse said user data; and determine a correlation for at least a portion of the parsed data, wherein said correlation may be based, at least in part, on one or more database queries.

However, Murphy discloses said web server is further configured to, in operation: at least partially parse said user data; and determine a correlation for at least a portion of the parsed data, wherein said correlation may be based, at least in part, on one or more database queries (see col 4, lines 6-16, and col 4, lines 50-64 and claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add determining a correlation between said received data and data stored in one or more databases to the system of Anderson et al.. One would have been motivated to do this in order to make appropriate inferences about customer's needs.

As per Claim 37:

Anderson et al. discloses said one or more web servers of said ad network are capable of returning electronic data in the form of one or more ads (see paragraphs [0028], [0029]).

As per Claim 38:

Anderson et al. discloses said web site server is capable of generating an ad by use of said returned electronic data at least in part (see paragraphs [0029], [0062]).

As per Claim 39:

Anderson et al. does not explicitly disclose said ad network is further configured to, in operation: parse at least a portion of the sent electronic data; query one or more databases with at least a portion of the parsed data; and provide said returning electronic data based at least in part on said query.

However, Murphy discloses said ad network is further configured to, in operation: parse at least a portion of the sent electronic data; query one or more databases with at least a portion of the parsed data; and provide said returning electronic data based at least in part on said query (see col 4, lines 6-16, and col 4, lines 50-64 and claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add parsing at least a portion of the sent electronic data; query one or more databases with at least a portion of the parsed data; and providing said returning electronic data based at least in part on said query to the system of Anderson et al.. One would have been motivated to do this in order to make appropriate inferences about customer's needs.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Monday through Thursday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6102.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Arthur Duran/

Primary Examiner, Art Unit 3622